

## **REMARKS**

The Office Action rejected claims 10-21 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent 5,299,288 issued to Glassman et al. (“Glassman”) in view of United States Patent 6,144,875 issued to Schweikard et al. (“Schweikard”). The Office Action rejected claims 10, 13-14, and 17-19 on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 5-8, 17, and 20 of co-pending Application 09/793,828.

In this Amendment, Applicant has amended the specification to include claim of benefit to previously filed applications. The amendment to the specification adds claim of benefit to applications listed on the transmittal at the time of filing and accepted by the USPTO as shown by the filing receipt of 10/08/2003, a copy of which is attached hereto. Accordingly, under MPEP § 201.11(III)(D), no petition is required to enter the claim of benefit amendment.

In this Amendment, Applicant has also amended claims 10, 13-14, and 17-19 for reasons of clarity. Applicant does not surrender any equivalents to any amended limitations or elements of any claim. Applicant has added claims 22-29. Accordingly, claims 10-29 will be pending after entry of this Amendment. Applicant respectfully requests reconsideration of the rejections.

### **I. Rejection of Claims 10-13 Under 35 U.S.C. § 103(a)**

The Office Action rejected claims 10-13 under 35 U.S.C. § 103(a) as being unpatentable over Glassman in view of Schweikard. Claims 11-13 and 22-24 are dependent directly or indirectly on claim 10. Claims 15-17 and 25 are dependent directly or indirectly on claim 14. Claims 19-21 and 26-27 are dependent directly or indirectly on claim 18.

Applicant respectfully submits that the claims as written are patentable over Glassman in view of Schweikard. However, in order to expedite allowance, Applicant has submitted a declaration under 37 C.F.R. § 1.131 swearing behind Schweikard. As Schweikard is not prior art for claims 10-

21, in view of the submitted § 1.131 declaration, Applicant respectfully requests withdrawal of §103(a) rejection of claims 10-21.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejections of claims 10-21.

## **II. Double Patenting Rejections of claims 10, 13-14, and 17-19**

The Office Action rejected claims 10, 13-14, and 17-19 on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 5-8, 17, and 20 of co-pending Application 09/793,828. The Office Action stated that the differences between the two applications are that the present application tracks the movement of the target point while Application 09/793.828 tracks the movement of the instrument from the target point. *See*, Office Action, page 3. The Office Action states that these are obvious variations of each other. The Office Action states that “it would have been obvious to one of ordinary skill in the art to track either the relative motion of the instrument or the relative motion of the target site since the displacement is in terms of movement and either way of measuring the displacement, relative to the target point or relative to the instrument, describes the same relative position.” Office Action, page 3, lines 12-16. However, tracking the position of a target is not the same as tracking the position of an instrument. As an analogy, knowing the location of someone you are looking for is different from knowing your own location. In that analogy, knowing that you have taken a wrong turn is different from knowing that the person you are looking for has moved to a different location. A system that lets you know when the person you are looking for has moved would not be obvious in view of a system that lets you know when you have made a wrong turn, even if both systems also told you how to change your position so as to reach the person.

For these applications, tracking the position of a target requires a way of knowing the position of the target. Tracking the position of an instrument requires a way of knowing the position

of the instrument. The mere fact that the instrument's orientation is corrected in both Applications does not mean that claims that recite the extremely different elements of tracking an instrument and tracking a target are obvious in view of each other.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the non-statutory obviousness type double patenting rejection of claims 10, 13-14, and 17-19.

### **III. New Claims 28-29**

Applicant has added new claims 28-29. Applicant respectfully submits that the claims are fully supported by the specification and drawings and are valid over the cited references. Applicant respectfully requests that the claims be allowed as soon as possible.

## CONCLUSION

In view of the foregoing, Applicant respectfully submits that all the claims, namely claims 10-29, are in condition for allowance. Reconsideration of the rejections is requested. Allowance is earnestly solicited at the earliest possible date.

Applicant has submitted all known required fees. Applicant believes that no additional fee is required for the submission of this Amendment and Response. However, in the unlikely event that the Commissioner determines that additional fees, extensions of time, and/or other relief are required, Applicant petitions for any required relief. Moreover, Applicant authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. **50-3804** referencing **STAN.P0010C**.

For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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